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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,008	07/17/2003	Keith Alexander Harrison	B-5172 621109-9	4584

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

SMITHERS, MATTHEW

ART UNIT	PAPER NUMBER
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2137

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/12/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/623,008

Applicant(s)

HARRISON ET AL.

Examiner

Matthew B. Smithers

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 9-11, 17-19, 21 and 22 is/are rejected.
- 7) ☒ Claim(s) 4-8, 12-16 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 7/17/03; 8/2/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

The information disclosure statements filed July 17, 2003 and August 4, 2005 have been placed in the application file and the information referred to therein has been considered as to the merits.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 22 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 22 is directed to a computer program product for causing an apparatus to execute specific method steps. In order for a computer program product to fall within one of the four statutory classes of an invention it must have the necessary physical article or objects that constitute a machine or manufacture within the meaning of 35 USC 101. In the instant application, the claim for the computer program product lacks a computer readable medium such as a (ROM, RAM, CD, DVD or other storage memory device) and the specification fails to teach a computer program product comprising the computer readable storage medium. Therefore, claim 22 is considered non statutory.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 9-11, 17-19, and 21 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by US 20040240666 granted to Cocks.

Regarding claim 1, Cocks meets the claimed limitations as follows:

“A method of securely transferring first and second data from a user to first and second parties respectively, wherein: the user encrypts the first data using a first encryption key associated with the first party, and then encrypts the second data using, as encryption parameters, both public data of said first party and third data comprising the encrypted first data; the third data is provided to the first party and the encrypted second data is provided to the second party; the first party uses a first decryption key to decrypt the encrypted first data, as provided to the first party in said third data, whereby to recover the first data; the first party also using the third data, along with private data related to said public data, to generate a second decryption key; the second decryption key is provided to the second party which uses it to decrypt the encrypted second data.”
see paragraphs [0011]-[0045]; paragraphs [0051]-[0072] and Figures 1 and 2.

Regarding claim 2, Cocks meets the claimed limitations as follows:

"A method according to claim 1, wherein the first encryption key corresponds to a public key associated with the first party and for which that party has a corresponding private key that constitutes said first decryption key." see paragraphs [0011]-[0045]; paragraphs [0051]-[0072] and Figures 1 and 2.

Regarding claim 3, Cocks meets the claimed limitations as follows:

"A method according to claim 1, wherein the first encryption key and the first decryption key are the same." see paragraphs [0011]-[0045]; paragraphs [0051]-[0072] and Figures 1 and 2.

Claims 9-11 are system claims that are substantially equivalent to method claims 1-3.

Therefore, claims 9-11 are rejected by a similar rationale.

Claims 17-19 are apparatus claims that are substantially equivalent to method claims 1-3. Therefore, claims 17-19 are rejected by a similar rationale.

Regarding claim 21, Cocks meets the claimed limitations as follows:

"Apparatus according to claim 17, wherein the fourth means is arranged to send the third data set, together with the encrypted second data set, to said another party for the latter to provide the third data set to the trusted authority." see paragraphs [0011]-[0045]; paragraphs [0051]-[0072] and Figures 1 and 2.

Regarding claim 22, Cocks meets the claimed limitations as follows:

"A computer program product arranged to condition computing apparatus, when installed thereon, to provide: first means for forming a first data set comprising a

message intended for a trusted authority; second means for encrypting the first data set using an encryption key associated with the trusted authority; third means for encrypting a second data set using, as encryption parameters, both public data of the trusted authority and a third data set comprising the encrypted first data set; fourth means for outputting the encrypted second data set for provision to another party and for outputting the third data set for provision to the trusted authority.” see paragraphs [0011]-[0045]; paragraphs [0051]-[0072] and Figures 1 and 2.

Allowable Subject Matter

Claims 4-8, 12-16 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

With respect to claims 4-8 and 12-16, the cited prior art fails to specifically teach wherein the first data comprises a message with interpretable content; wherein said message comprises an instruction to the first party to carry out a specific action, the first party interpreting the recovered first data and carrying out said specific action; wherein said message comprises a condition to be satisfied before the second decryption key is provided to the second party, the first party interpreting the recovered first data and ensuring that said condition is satisfied before it generates said second decryption key and/or provides that key to the second party; wherein the third data further comprises at

least one of a random number and a time indication; and wherein the user sends the encrypted second data, together with the third data, to the second party; the second party providing the third data to the first party.

With respect to claim 20, the cited prior art fails to specifically teach wherein the third data set further comprises at least one of a random number and a time indication.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A. Mont (US 20040010700) discloses a system for validating software code provided by a software distributor using an identity based encryption scheme.

B. Chang (US 20030084001) discloses a system for securing transaction information via a third party.

C. Mirlas et al (US 20020174075) discloses a system for on-line payments to a merchant using a bank as the trusted third party.

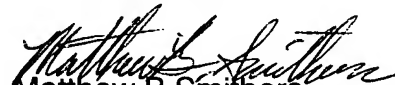
D. Tsiounis et al (US 20010039535) discloses a system for making secure electronic payments.

E. Hillier et al (US 7,142,676) discloses a system for securely communicating data using a third party key provider.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew B. Smithers whose telephone number is (571) 272-3876. The examiner can normally be reached on Monday-Friday (8:00-4:30) EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel L. Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Matthew B Smithers
Primary Examiner
Art Unit 2137